

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Christopher M. SCHMANDT, et al.

Application No.: 09/912,352

Group Art Unit: 2614

Confirmation No.: 5411

Filed: July 26, 2001

Examiner: Gauthier, Gerald

For: Voice-based Message Sorting and Retrieval Method

RESPONSE TO NON COMPLIANT AMENDMENT

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

This is a response to the Notice of Non-Compliant Amendment mailed on August 28, 2008, having a shortened period for response set to expire on September 29, 2008 (September 29, 2008 occurring on a Sunday).

In response to the Restriction Requirement mailed June 9, 2008, a Response was filed on July 9, 2008. As pointed out by the Applicants in the response filed on July 9, 2008 regarding the Restriction Requirement mailed June 9, 2008, the Examiner classified claims 31-35 as part of Group I while classifying claim 36 as part of Group II (claims 31-35 depend from claim 36).

The Examiner issued a Non-Compliant Amendment on August 28, 2008 pointing out the Examiner's own incorrect classification as pointed out by the Applicants in the response filed July 9, 2008 (see, page 2 of attached Response filed on July 9, 2008). The Examiner's issuance of this improper Response is taken as acknowledgement of the Examiner's improper classification of claims 31-35 and 36 in different groups.

Applicants provisionally elect claims 1-36, 44-48, and 52-63 and again traverse the Restriction Requirement (see, Response filed on July 9, 2008 a copy of which is enclosed). Further, since claims 37-41 depend from claim 36, Applicants also elect claims 37-41. Thus, Applicants provisionally elect claims 1-41, 44-48, and 52-63.

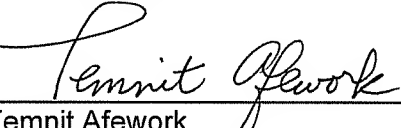
In order to avoid delay in prosecution, Applicants respectfully request that the Examiner contact the undersigned if there are any formal matters remaining after this response.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 09/29/2008

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Group Art Unit: 2614

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Filed: July 26, 2001

Examiner: Gauthier, Gerald

For: Voice-based Message Sorting and Retrieval Method

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This is responsive to the Office Action mailed June 9, 2008, having a shortened period for response set to expire on July 9, 2008, the following remarks are provided.

I. Provisional Election of Claims Pursuant to 37 CFR §1.142

Applicants provisionally elect claims 1-35, 44-48 and 52-63 (indicated as Group I) in the Restriction Requirement dated June 9, 2008.

II. Applicants Traverse the Requirement

Insofar as Group II (claims 36-41 and 49-51) and Group III (claim 64) are concerned, it is believed that claims 36-41, 49-51 and 64 are so closely related to elected claims 1-35, 44-48 and 52-63 that they should remain in the same application. The elected claims 1-35, 44-48 and 52-63 directed to categorizing messages, for example, may be used for presenting newly-arrived messages (claims 36-41 and 49-51) including where an addressee manages the sorting of the messages (claim 64). There have been no references cited to show any necessity for requiring restriction, and in fact, it is believed that the Examiner would find references containing the asserted groups of claims in the same field of technology. Further, the Applicants respectfully submit that evaluation of all claims would not provide an undue burden upon the Examiner at this time in comparison with the additional expense and delay to the Applicants in having to

protect the additional subject matter recited by the Group II and/or Group III claims by filing a divisional application.

MPEP §803 sets forth the criteria for restriction between patentably distinct inventions. (A) indicates that the inventions must be independent (see MPEP §802.01, §806.04, §808.01) or distinct as claimed (see MPEP §806.05-806.05(i)); and (B) indicates that there must be a serious burden on the Examiner if restriction is required (see MPEP §803.02, §806.04(a)- §806.04(i), §808.01(a) and §808.02). The Examiner has not set forth why there would be a serious burden if restriction is required.

Further, the Examiner classifies claims 31-35 as part of Group I while classifying claim 36 as part of Group II. However, in the Amendment submitted on July 16, 2007, claims 31-35 were amended to depend from claim 36. Thus, it is respectfully submitted that the Restriction Requirement is erroneous.

III. Conclusion

Upon review of references involved in this field of technology, when considering that elected claims 1-35, 44-48 and 52-63, claims 36-41, 49-51 and claim 64 are respectively directed to categorizing, sorting and retrieval of messages, and when all of the other various facts are taken into consideration, it is believed that all of the pending claims should be examined in the subject application.

Respectfully submitted,

STAAS & HALSEY LLP

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